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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |          |                 |
|--|-------------|----------------------|---|------------------|----------|-----------------|
| 10/618,808   | 07/14/2003  | Bing Zhou            | 15913.39.1  | 5792             |          |                 |
| 22913  | 7590        | 04/06/2005           | <table border="1"><tr><td>EXAMINER</td></tr><tr><td>LANGEL, WAYNE A</td></tr></table> |                  | EXAMINER | LANGEL, WAYNE A |
| EXAMINER   |             |                      |   |                  |          |                 |
| LANGEL, WAYNE A  |             |                      |   |                  |          |                 |
| WORKMAN NYDEGGER<br>(F/K/A WORKMAN NYDEGGER & SEELEY)<br>60 EAST SOUTH TEMPLE<br>1000 EAGLE GATE TOWER<br>SALT LAKE CITY, UT 84111 |             |                      | ART UNIT  | PAPER NUMBER     |          |                 |
| 1754   |             |                      |   |                  |          |                 |
| DATE MAILED: 04/06/2005  |             |                      |   |                  |          |                 |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/618,808             | ZHOU ET AL.         |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Wayne Langel           | 1754                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-70 is/are pending in the application.
  - 4a) Of the above claim(s) 37-70 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-36 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) 1-70 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11-14-03 and 9-1-04
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 2-30 and 32-36, drawn to a catalyst, classified in class 502, subclass 185.
- II. Claims 37-52, drawn to a method for making a catalyst, classified in class 502, subclass 185.
- III. Claims 53-70, drawn to a method for making hydrogen peroxide, classified in class 423, subclass 584.

Claims 1 and 31 link(s) inventions I, II and III. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1 and 31. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because:

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Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make another and materially different product, such as a product which does not include the detailed limitations as recited in claims 2-30 and 32-36.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced can be practiced with another and materially different product, such as a product which does not include the detailed limitations as recited in claims 2-30 and 32-36.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions, i.e., the function of making the catalyst versus the function of using the catalyst.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Guynn on March 17, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 2-30 and 32-36. Affirmation of this election must be made by applicant in replying to this Office action. Claims 37-70 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Zhou et al '775. No distinction is seen between the catalyst disclosed by Zhou et al '775, and that recited in claims 1-36. Zhou et al '775 discloses a method for forming a supported noble metal catalyst, wherein a polymer is added to the precursor solution. (See col. 6, lines 17-54.) The polymer in the process of Zhou et al '775 would inherently chemically bind at least a portion of the reactive catalyst particles to the support material to no less extent than it would in the catalyst recited in claims 1-36, thus inherently resulting in the properties recited in these claims. In any event, any differences between the catalyst of Zhou et al '775, and that recited in claims 1-36, would be *prima facie* obvious. Regarding claims 31-36, these claims do not exclude the noble metal catalyst of Zhou et al '775, since the phrase "selected from the group comprising..." in claim 31 does not close the group to the recited members.

Claims 1-36 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Zhou et al '661. No distinction is seen between the catalyst disclosed by Zhou et al '661, and that recited in claims 1-36.

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Zhou et al '661 discloses a method for forming a supported noble metal catalyst, wherein a polymer is added to the precursor solution. (See col. 6, line 53 to col. 9, line 11, especially col. 8, lines 23-41). The polymer in the process of Zhou et al '661 would inherently chemically combine at least a portion of the reactive catalyst particles to the support material to no less extent than it would in the catalyst recited in claims 1-36, thus inherently resulting in the properties recited in these claims. In any event, any differences between the catalyst disclosed by Zhou et al '661, and that recited in claims 1-36, would be *prima facie* obvious. Regarding claims 31-36, these claims do not exclude the noble metal catalyst of Zhou et al '661, since the phrase "selected from the group comprising..." in claim 31 does not exclude the group to the recited members.

Claims 1-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation of "selected from the group comprising..." is improper Markush terminology. The phrase should be changed to -- selected from the group consisting of... -- to avoid this rejection.

Any inquiry concerning this communication should be directed to Wayne Langel at telephone number 571-272-1353.



Wayne A. Langel  
Wayne Langel  
Primary Examiner  
Art Unit 1754